

REMARKS

In the outstanding Final Office Action mailed June 1, 2005, the Examiner (1) withdrew claims 50-69 from consideration as being directed to a non-elected invention; (2) rejected claims 45-49 under nonstatutory double patenting over claims 1-8 of *Wendlandt et al.* (U.S. Patent No. 6,736,773); (3) rejected claims 45-49 under 35 U.S.C. §102(b) as being clearly anticipated by *De Faria-Correa et al.* (U.S. Patent No. 5,533,496); and (4) rejected claim 45 under 35 U.S.C. §102(b) as being clearly anticipated by *Thompson* (U.S. Patent No. 5,762,603).

By this Amendment, Applicants cancel claims 50-69 without prejudice or disclaimer. Applicants reserve the right to re-present the subject matter of those claims at a later date, for example, in an application claiming priority to or having related priority to this application. Claims 1-44 were previously canceled in an Amendment filed on April 13, 2005. Claims 45-49 are therefore the pending claims.

I. NONSTATUTORY DOUBLE PATENTING REJECTION

The Examiner rejected claims 45-49 under the judicially created doctrine of double patenting as being unpatentable over claims 1-8 of Applicants' prior U.S. Patent 6,736,773. Although Applicants disagree with this rejection, Applicants have filed a Terminal Disclaimer concurrently with this Amendment in order to facilitate prosecution of this application. Accordingly, Applicants request reconsideration.

II. §102(b) REJECTIONS OF CLAIM 45

Applicants submit that claims 45-49 are patentable under 35 U.S.C. §102(b) over *De Faria-Correa et al.*, *Thompson*, and the other art of record, for at least the reasons described below.

Applicants note that in order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th ed., 2001.

De Faria-Correa et al. discloses a cannula 27 having a working channel through which an endoscope 30 passes. The distal end of endoscope 30 forms a viewing tip 31. Attached to cannula 27 and encapsulating the distal end of cannula 27 and viewing tip 31 is a housing 1. Housing 1 protects viewing tip 31 and includes a window 2 through which viewing tip 31 can view the tissue area. (*De Faria-Correa et al.*, col. 5, ll. 20-38 and Fig. 3A).

The Examiner has characterized endoscope 30, which passes through cannula 27, as an extension arm. The Examiner further asserts that a "vision head 1" is attached to a distal end of the endoscope 30. Applicants note that this is incorrect. As shown in Figure 3A, housing 1 is attached to cannula 27 and not to endoscope 30. *De Faria-Correa et al.* does not disclose or suggest attaching any structure to a distal end of endoscope 30. Further, it should be noted that housing 1 is not connected to any structure that would permit it to be extendable away from cannula 27 or endoscope 30, nor is housing 1 configured to permit retrograde vision. Therefore, *De Faria-Correa et al.* fails to disclose or suggest *inter alia*: "a vision head attached to a distal end of the extension arm, the vision head being configured to extend away from the distal end of the endoscope to permit retrograde vision," as recited in independent claim 45. For at least these reasons, claims 45-49 are patentable over *De Faria-Correa et al.*

The Examiner has characterized *Thompson* as including an endoscopic device comprising an endoscope body 1 including an extension arm 29 passing through one lumen in the endoscope body 1 and a vision head 5 attached to a distal end of the extension arm 29, wherein the vision head 5 includes at least a vision chip or image sensor capable of receiving an image of a surgical site. Applicants note this is incorrect. *Thompson* discloses an imaging device 1 comprising a camera housing 5 and a camera cable 29, which extends between the camera housing 5 and an upper housing 3. The camera cable 29 contains conductors which carry a signal to the upper housing 3 and which supply electrical power to a CCD and lights 13. Further, an elevation motor 51 drives an elevation shaft 53, thereby causing the camera housing 5 to elevate or depress. (*Thompson*, col. 2, line 33 – col. 3, line 24). *Thompson* does not disclose or suggest that camera housing 5 is extendable away from imaging device 1. Further, camera housing 5 is not configured to permit retrograde vision. Therefore, *Thompson* fails to disclose or suggest *inter alia*: “a vision head attached to a distal end of the extension arm, the vision head being configured to extend away from the distal end of the endoscope to permit retrograde vision,” as recited in independent claim 45. For at least these reasons, claim 45 is patentable over *Thompson*.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 45-49 in condition for allowance. As noted above, the proposed cancellation of claims 50-69 does not raise new issues. Therefore, this Amendment should allow for immediate action by the Examiner.

In addition, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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